

REMARKS

This application has been carefully reviewed in light of the Office Action mailed October 15, 1998. To advance prosecution of this case, the Examiner's rejection of the claims is respectfully traversed. Applicants respectfully request reconsideration and favorable action.

The Examiner rejects Claims 1-20 under the Recapture Doctrine as set forth in M.P.E.P. § 1412.02.

The Recapture Doctrine can apply in three situations. First, as stated in M.P.E.P. § 1412.02, the Recapture Doctrine bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than claims canceled from the original application. Second, courts have held that amending claims to overcome prior art can also trigger the application of the Recapture Doctrine. *Mentor Corp. v. Coloplast Inc.*, 27 U.S.P.Q.2d 1521 (Fed. Cir. 1993). Third, the Federal Circuit recently held that under certain circumstances arguments in regards to patentability can trigger the Recapture Doctrine, even if no claims were amended or canceled. *Hester Industries, Inc. v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998).

In interpreting the Recapture Doctrine, the Federal Circuit stated in *Mentor Corp. v. Coloplast Inc.*, 27 U.S.P.Q.2d 1521 (Fed. Cir. 1993), upon which the Examiner relies, that the Recapture Doctrine "does not apply where there is no evidence that amendment of the originally filed claims was in any sense an admission that the scope of that claim was not in fact patentable." *Id.* at 1524. As the Federal Circuit made clear, although error under the reissue statute "does not include a deliberate decision to surrender specific subject matter in order to overcome prior art," if a reissue claim is broader "in a way that does not attempt to reclaim what was surrendered earlier," the Recapture Doctrine does not apply. *Id.* at 1525.

Applying the law cited above to the present reissue application, it is abundantly clear that Applicants made no deliberate decision in prosecuting the original application to surrender the liquid filter subject matter to overcome prior art, as required for the Recapture Doctrine to apply. Furthermore, the reissue claims in this application are broader than the original patent claims in a way that does not attempt to reclaim subject matter, if any, that might possibly have been surrendered in prosecuting the original application. The file history of the original patent shows the Recapture Doctrine to be inapplicable to the claims of the present reissue application. Consequently, Applicants respectfully traverse the Examiner's rejection below.

Considering the first situation where the Recapture Doctrine can apply, it is clear that Applicants are not trying to acquire any subject matter that was explicitly canceled during prosecution.

Considering the second situation where the Recapture Doctrine can apply, Applicants are not trying to recapture subject matter that was added as a narrowing limitation to a claim to specifically overcome prior art. In Applicant's response to Examiner's action dated June 25, 1997, Applicants pointed out that any amendment with regard to "a liquid filter for capturing said particulate matter contained in said fired exhaust and for chemically treating said fired exhaust gases to reduce the quantity of CO, NO, and SO contained in the fired exhaust" was done to be in compliance with § 112 and not as a narrowing limitation to overcome cited art. Since application of the Recapture Doctrine to the liquid filter element requires a deliberate intention on the part of Applicants to surrender subject matter associated with the liquid filter element to overcome prior art, and since Applicants repeatedly and consistently argued that the liquid filter element was not necessary to distinguish over the prior art, there is no basis to apply the Recapture Doctrine to Claim 1 and Claim 22 (now Claim 15). This argument was made in Applicant's response to Examiner's action dated June 25, 1997 and no response to this argument was made. Presumably this issue is now closed.

Considering the third situation where the Recapture Doctrine can apply, the Examiner, in the latest Official Action, relies on *Hester Industries* to support the Recapture Doctrine. The Examiner correctly points out that in *Hester Industries* the Federal Circuit held that "in a proper case, a surrender can occur through arguments alone." *Hester Industries* at 1649. In determining that the case before it was "a proper case", the Federal Court noted that *Hester Industries* was attempting to recapture what *Hester Industries* had indicated during prosecution was the primary basis for distinguishing the broadest claim over prior art. The Court additionally noted that *Hester Industries* had claimed that the limitations sought to be removed via reissue were critical and very material to patentability. In view of the actual holding of *Hester Industries*, the present case is not "a proper case" to hold that the Recapture Doctrine applies since Applicants never argued that the liquid filter element was the primary basis for overcoming prior art and since Applicants never argued that the liquid filter element was critical or very material with regards to patentability.

The Examiner points to several examples where Applicants argued that the liquid filter element was not shown in the prior art. The Examiner concludes that in so doing the Recapture Doctrine now applies. This conclusion is wrong. The holding in *Hester Industries* was not that any time a patentee argued that a limitation was not disclosed, taught or suggested in the prior art that the limitation was surrendered for purposes of the Recapture Doctrine. Instead, the Court held, as discussed earlier, that surrender can occur in certain fact specific "proper cases". Applicants respectfully submit that this is not a proper case to assert the Recapture Doctrine.

The Examiner points to paper 5, page 4, filed August 15, 1991 to support the position that Applicants have surrendered the liquid filter to the Recapture Doctrine. In the cited section, Applicants are merely pointing out that the prior art fails to disclose a liquid filter. On page 5 of paper 5 the Applicants conclude:

Applicants have shown that each of the references relied on omit critical features of Applicants' invention. Moreover, no reference teaches or suggests the use of first and second combustion chambers where the first combustion chamber incinerates waste material "in an oxygen rich atmosphere" and the second combustion chamber incinerates the fired exhaust in an "oxygen starved atmosphere." *In addition*, no reference teaches or suggests a liquid filter that both captures particulate matter and treats the exhaust "to reduce the quantity of CO, NO and SO."

(emphasis added). Thus, Applicants never argued that the liquid filter was the primary reason to overcome the reference nor did Applicants argue that the liquid filter was critical or very material to patentability. It is simply listed as one of several reasons why the prior art fails to disclose, teach or suggest the present invention.

The Examiner further points to Applicants' Appeal Brief, filed on October 26, 1992 to support the contention that Applicants surrendered the liquid filter to the Recapture Doctrine. Again, Applicants were simply arguing that there were several reasons why the prior art failed to disclose, teach, or suggest all the limitations of the present application. As Applicants stated on Page 4 of the Appeal Brief, "the Houser patent does not show, teach, or suggest (1) an oxygen enriched first combustion chamber, (2) an oxygen starved second combustion chamber, or (3) a liquid filter as claimed by Applicants." (emphasis added) Applicants then independently argued on Pages 4-8 the differences between each of these elements and Houser, Hadley, and Kent. In concluding the Appeal Brief, on Page 8, Applicants stated:

The three references cited as prior art do not show, teach, or suggest using air injectors to inject air and waste material into an oxygen rich first combustion chamber, delivering exhaust to an oxygen starved second combustion chamber, *or* using a liquid filter to remove the specified chemicals . . . as expressly claimed by Applicants.

(emphasis added). Applicants did nothing more than argue the numerous distinctions between their invention and the prior art. Applicants did not in any way express the liquid filter element in such a manner that the Applicants made it the primary basis for distinguishing over the prior art or made it the critical or very material difference. It is simply argued as one of several distinctions. Therefore, the Recapture Doctrine is wholly inapplicable in the present situation and the Examiner's rejection should be withdrawn.

Indeed, in seeking the original patent, Applicants repeatedly and consistently argued that the recited combustion chambers and the order of their operation were important aspects of the invention and entirely sufficient to define over the prior art. The mere fact that Applicants also pointed out that the prior art failed to teach or suggest the recited filter element, with its ability to reduce the quantity of CO, NO, SO, HCL, or SO₂, does not in any way amount to an admission that the recited filter element was necessary to overcome the prior art. This certainly is not a proper case where the Applicants has made "unmistakable assertions . . . to the Patent Office . . . [that] can give rise to a surrender for purposes of the Recapture Doctrine." (emphasis added, *Hester Industries* at 1649).

Finally, the Examiner asserts that since the Reason for Allowance section of Paper No. 20, mailed December 22, 1992, states "inclusion of 'the liquid filter of chemically treating the exhaust gases to reduce CO, NO and SO gases' which the prior art references fail to show or suggest," and since no remarks from Applicants followed, Applicants are deemed to have agreed with the Examiner and the Recapture Doctrine applies. This argument is clearly wrong. Actually, the opposite conclusion is true. 37 C.F.R. 104(e) clearly states that "The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the Examiner. Failure to file such a statement does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner." Indeed, the mere fact that an Examiner lists a reason for allowance does not lead to the conclusion that the listed reason (or reasons) is the sole reason for allowance: "The statement

Reasons for
allowance

is not intended to necessarily state all the reasons for allowance or all the details why claims are allowed and showed not be written to specifically or impliedly state that all the reasons for allowance are set forth." M.P.E.P. 1302.14.¹ Thus, it is improper for the Examiner to claim that just because one reason is listed in the Reasons for Allowance, does not mean it was the only reason the Examiner used to determine the applicants' invention was patentable.

Therefore, in view of the governing law and the file history of the original patent, Applicants are not trying to recapture any matter that was canceled during prosecution. Nor were any narrowing limitations made to the liquid filter element to overcome the prior art, as demonstrated in the above discussion of Paper No. 12. Finally, under the recent decision of *Hester Industries Inc. v. Stein, Inc.*, no comments made during the prosecution of the application rise to the extent of those shown in Hester and do not trigger the surrender of subject matter. Therefore, Applicants did not surrender the subject matter of the liquid filter element under the Recapture Doctrine as it applies to amendments made to claims during prosecution. For all of the reasons discussed above, Applicants respectfully request reconsideration and the allowance of Claims 1-20.

¹ See *Leeds v. Commissioner of Patents and Trademarks*, 955 F.2d 757 (D.C. 1992). This case notes "[a] Rule 109 statement does not purport to contain a complete (or standing alone, comprehensible) rationale as to why a patent has been allowed. . . . There may of course be several important reasons why a patent is allowed, some of which is clear from the record without an additional Rule 109 statement, and some of which in the interest of completeness requires one. An interested party would in all cases have to read the entire file (and not just the Rule 109 statement) to understand why a patent is allowed." Rule 109 is now listed as 104(e).

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this case in any manner, the Examiner is invited to contact the undersigned Attorney for Applicants at the Examiner's convenience.

Although Applicants believe that no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

BAKER & BOTTTS, L.L.P.
Attorneys for Applicants



Robert M. Chiaviello, Jr.
Reg. No. 32,461

2001 Ross Avenue
Dallas, Texas 75201-2980
(214) 953-6677

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